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Docket No.: 10004909-1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In the Application of	§	
	§	
John M. Baron	§	
	§	
Serial No.: 09/765,172	§	Art Unit: 2674
	§	
Filed: January 18, 2001	§	Examiner: J. Nguyen
	§	
For: A SYSTEM FOR A NAVIGABLE DISPLAY	§	

REPLY BRIEF

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REPLY TO EXAMINER'S ANSWER UNDER (37C.F.R. 1.193(b)

Dear Sir:

I. ARGUMENTS

Appellant respectfully requests withdrawal of the final rejection, re-opening of prosecution, and allowance of the above-captioned application. Should the Primary Examiner not find the comments contained herein persuasive, acknowledgment of receipt and entry of this Reply Brief is requested.

A. Introduction

For the reasons set forth in Appellant's Brief and set forth herein below, Appellant requests the Board of Patent Appeals and Interferences (the "Board") reverse the Examiner's rejections in the event that the rejections are not withdrawn prior to reaching the Board.

B. The First Issue

The first issue may be stated as follows:

Whether the switch platform mounted to detect a touching about a periphery of the display of claims 1–20 is anticipated or rendered obvious by Brisebois'

edge user interface element, which is separate but, at most, adjacently touching its disclosed display, alone or in combination with Goto.

Brisebois' edge user interface device is separate, or at most, adjacently touching a display device. Such active edge user interface device is different than the switch platform claimed in the present application. Such differences mean that *Brisebois* does not anticipate nor render obvious (when in combination with *Goto*) the present claims.

Brisebois teaches that the "[a]ctive edge input device 120 is a user interface device positioned adjacent [to] display 110. Active edge input device 120 may actually touch display 110 or lay a predetermined distance away from an edge of display 110." Col. 3, lines 48-51. When the Examiner asserts that *Brisebois* teaches that it would be desirable to position a touch interface overlapping onto the display device, the Examiner extends the teaching of *Brisebois* too far. As an example, reading passages and figures from *Brisebois* cited by the Examiner herself reveals that *Brisebois* does not teach "the switch platform mounted to detect a touching about a periphery of said display," as in claims 1-20.

On page 7 of the Examiner's Answer, the Examiner cites four passages and three drawings from *Brisebois* which she uses to buttress her argument that the features recited in claim 1 are disclosed by *Brisebois*. The Examiner cites Figs. 1-3, Col. 1, lines 4-13, Col. 3, lines 20-67, Col. 5, line 49 to Col. 6, line 26, and Col. 7, lines 47-52. As described below, some of these passages and drawings are irrelevant; however, the rest are consistent with Appellant's arguments and support Appellant' s proposition that *Brisebois* does not teach "the switch platform mounted to detect a touching about a periphery of said display."

First, the Examiner cites Col. 3, lines 20-67 (a portion of which is cited above) to support her argument that *Brisebois* teaches the features of the claims of the present application. This passage describes Figure 1 and reads in lines 49-51 that the active edge interface device may lay a predetermined distance away from the display or may actually touch the display. Figure 1 depicts the active edge user interface device extending around the outside perimeter of the display device.

Col. 1, lines 4-13 recites that the active edge interface device is located "near the perimeter of a display." Though the Examiner cites this passage to support her argument that

Brisebois discloses the features of the claims at issue, the language of this passage clearly requires the active edge user interface device to be positioned outside of the display.

Col. 5, line 49 through Col. 6, line 26 describes Figs. 2b, 2c, and 3a-3c. These cited passages and figures describe operation of the active edge user interface itself, but do not describe the position of the interface relative to the display. Thus, these cited passages and figures are irrelevant, even though they are cited by the Examiner as disclosing features of the claims at issue.

Finally, Col. 7, lines 47-52, which describes Figs. 4a and 4b, is cited by Examiner to argue that features of the claims at issue are disclosed by *Brisebois*. These cited passages and figures say that different areas of the active edge user interface may be associated with different functions. Much the same as the passages and figures described immediately above, these references do not describe the position of the interface device relative to the display. Thus, these cited passages and figures are irrelevant despite the Examiner's citation.

The relevant passages and figures (Col. 3, lines 20-67, Figure 1, and Col. 1, lines 4-13) have in common a teaching that the edge user interface device of *Brisebois* lies outside the display device. While the edge user interface device may touch the outside perimeter of the display, it may not overlap with the display. Col. 1, lines 55-61 and Col. 2, lines 1-5 in *Brisebois*. Thus, the teaching of *Brisebois* does not extend so far that it teaches "the switch platform mounted to detect a touching *about a periphery of said display*" (Emphasis added), as required in the claims of the application at issue.

Accordingly, *Brisebois* does not teach each and every limitation of the claims at issue. Since *Goto* also does not teach "the switch platform mounted to detect a touching about a periphery of said display," neither *Brisebois* nor a combination of *Brisebois* and *Goto* render the claims unpatentable.

Further, On page 7 of the Examiner's Answer, the Examiner suggests that claims 5, 6, 8, and 15 of the present application are inconsistent with Applicant's argument that the claim feature, a "switch platform mounted to detect a touching about a periphery of said display," is different than the *Brisebois* edge user interface element that is separate or at most, adjacently touching a display. The Examiner tries to suggest that the claims 5, 6, 8, and 15 require a

switch platform similar to the *Brisebois* edge user interface in that they too are separate or at most, adjacently touching the display. However, the Examiner fails to appreciate the language of these claims. For example, the Examiner quotes in her answer the language of claim 5, "...said switch platform comprises pressure sensitive switches mounted in proximity to respective edges of said display..." This language of claim 5 describes that the switches, not the switch platform, are mounted in proximity to the edges of the display. It is the switch platform that is "mounted to detect a touching about a periphery of said display," and it is consistent with the argument that Applicant has proposed throughout prosecution. Thus, Appellant's arguments and claims are consistent.

In summary, *Brisebois*' edge user interface device is separate, or at most, adjacently touching a display device; therefore, the *Brisebois* device is different than the switch platform claimed in the present application. Such differences mean that *Brisebois* does not anticipate nor render obvious (when in combination with *Goto*) the present claims. Based on the foregoing, Appellant respectfully submits that claims 1, 2, 5, 6, 8, and 10-12 are patentable under 35 U.S.C. § 102(e) and that the rejections of claims 1-17 should be reversed.

C. The Second Issue

The second issue may be stated as follows:

Whether Brisebois *and* Goto *have been properly combined by the Examiner in alleging a rejection under 35 U.S.C. § 103.*

A combination of *Brisebois* and *Goto* is improper because the disclosure in each reference teaches against such a combination.

On page 8 of the Examiner's Answer, the Examiner argues that the combination of *Brisebois* and *Goto* is properly motivated. To make such a combination, however, the prior art must also suggest the desirability of the modification. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. § 2143.01. The Examiner fails to take into consideration that *Brisebois* in Col. 1, line 55 through Col. 2, line 5 teaches against such a combination. *Brisebois*, in the cited passage, expressly teaches that such a combination of display and touch interface would be disadvantageous:

> Although convenient, touch-screen systems such as the touch-screen interface of the '471 patent have disadvantages. Removable templates on a touch-screen display can be lost, destroyed, or misplaced, and when using a finger to select an item on a touch-screen, the user's hand can often block a view of the screen. Furthermore, touch-screens quickly become dirty, especially when installed in a public kiosk or an industrial environment...Therefore, it is desirable to provide an improved user interface device that is robust and ergonomically correct to create a user-friendly environment that does not require physical keys, templates, or touching the actual display.

Thus, the combination of *Brisebois* and *Goto* must fail because the motivation provided by the Examiner to combine the references is improper, as it must establish the desirability of making the combination.

For the reasons discussed above, Applicant respectfully asserts that a combination of *Brisebois* and *Goto* is improper because of lack of motivation to combine. Accordingly, Appellant respectfully submits that claims 3, 4, 7, 9, and 13-17 are patentable under 35 U.S.C. § 103(a) and that the rejection of claims 1-17 should be withdrawn.

D. Summary

Appellant requests the Examiner to reopen prosecution and allow this application. Failing that, appellant respectfully requests the Board to reverse the Examiner's rejection for the all the reasons set forth herein and as set forth in the Brief on Appeal.

Applicant has enclosed all fees believed due with this response. However, if additional fees are due or there is an overpayment, please use Deposit Account No. 08-2025, under Order No. 10004909-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV256035553US, in an envelope addressed to: MS Appeal Brief-Patents, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Date of Deposit: December 23, 2003

Typed Name: John Pallivathukal

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Respectfully submitted,

By _____

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